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PATENT
P55248

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re Application of:

Appeal No. _____

KWANG-YOUN PARK *et al.*

Serial No.: 09/100,952 Examiner: CHIEU, P.

Filed: 22 June 1998 Art Unit: 2615

For: METHOD AND APPARATUS FOR RESERVE-RECORDING A VIEWING BROADCAST PROGRAM

Attn: Board of Patent Appeals and Interferences

REPLY BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. §1.193(a) and (b), Appellant hereby requests entry of this Reply Brief in response to the Examiner's Answer mailed on 27 September 2002 (Paper No. 15).

This Reply Brief is filed in triplicate (37 C.F.R. §1.192(a)), together with a written Request for an Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

Folio: P55248
Date: 11/25/2
I.D.: REB/JGS/kf

REMARKS

The Examiner's Answer mailed on 27 September 2002 (Paper No. 15) has been carefully considered.

In the Answer, in response to arguments set forth in Appellant's Appeal Brief filed on July 25, 2002, the Examiner presents new arguments relative to the final rejection of claims 1 thru 12 under 35 U.S.C. §103 for alleged unpatentability over Young *et al*, U.S. Patent No. 5,479,266 in view of Lawler *et al.*, U.S. Patent No. 5,669,107 and Yuen *et al.*, U.S. Patent No. 6,154,203. Therefore, this Reply Brief is being submitted in order to respond to the new arguments set forth by the Examiner in the Answer mailed on September 27, 2002 (Paper No. 15).

In section 11B of the Answer, the Examiner responds to arguments contained on page 9 of the Appeal Brief by making reference to "the Office Action dated 10/18/01" (quoting from page 4 of the Examiner's Answer). In section 11C of the Answer, the Examiner responds to further arguments contained on page 9 of the Appeal Brief by again citing "the Office Action dated 10/18/01" (quoting from page 5 of the Answer). It is respectfully submitted that no such Office action is of record in this application.

Specifically, a first Office action (Paper No. 6) was mailed on April 24, 2001 in this application, and an Amendment and a Petition for Extension of Time (Paper Nos. 7 and 8) were filed on August 23, 2001. Then, a final Office action (Paper No. 9) was mailed on February 12, 2002, and

a Response After Final (Paper No. 10) was filed on May 10, 2002. Subsequently, an Advisory Action (Paper No. 11) was mailed on May 22, 2002, and a Notice of Appeal and a Petition for Extension of Time (Paper Nos. 12 and 13) were filed on June 12, 2002. Thus, the Examiner's reference to "the Office Action dated 10/18/01" is not understood, and does not support the arguments set forth in sections 11B and 11C of the Answer.

In section 11B (at the top of page 5 of the Answer), the Examiner contends that Yuen *et al.* '203 discloses "maintaining the viewing of the program while accessing program schedule information in figure 2" (quoting from the sentence bridging pages 4 and 5 of the Answer). However, the Examiner does not provide any citation to any portion of Yuen *et al.* '203 which actually discloses the features of the claimed method and apparatus, specifically the following features:

> "maintaining the viewing of the given broadcast program selected at step (b) without interruption while reading program identification information corresponding to the selected given broadcast program from the program identification information pre-stored at step (a)" (quoting from claim 1);
>
> "a controller for maintaining viewing of the given broadcast program when receiving the key input signal from the key input unit, for reading the program identification information corresponding to the given broadcast program from the first storage unit, and for setting reserve-recording information in accordance with the read program identification information" (quoting from claim 5); and
>
> "when the reserve key signal is input by the user during viewing of the given broadcast program, recognizing the given broadcast program being viewed as a broadcast program to be reserve-recorded, and maintaining the viewing of the given broadcast program without

interruption" (quoting from claim 9).

Furthermore, at the end of section 11B (appearing at the top of page 5 of the Answer), the Examiner alleges that the "combination of Young, Yuen, and Lawler is desirable because it allows the user to view program schedule information while viewing a given broadcast program, and to selecting [*sic*] the same program for reserve recording by reading the program identification information" (quoting from page 5, lines 3-6 of the Answer". However, this general statement by the Examiner, to the effect that Young *et al.* '266, Yuen *et al.* '203 and Lawler *et al.* '107 can be combined, and that the combination is "desirable", does not satisfy the requirements for combination of references under 35 U.S.C. §103. That is to say, whereas the Examiner has stated his own opinion as to why the combination of references might be "desirable", the Examiner has not cited any portion of Young *et al.* '266 which would motivate a person of ordinary skill in the art, upon reviewing the primary reference, Young *et al.* '266, to seek and incorporate the disclosures of Lawler *et al.* '107 and Yuen *et al.* '203 in order to modify the disclosure of Young *et al.* '266, and thereby to obtain the present invention. In the absence of such a suggestion or motivation in Young *et al.* '266, it must be concluded that the Examiner was able to combine these references based on improper hindsight, as assisted by the teachings contained in the present application. This is not a proper basis for a rejection under 35 U.S.C. §103 based on a combination of references.

In section 11E of the Answer, the Examiner responds to arguments contained on page 10 of the Appeal Brief. In that regard, the pertinent claim language is as follows:

From Claim 1:

"selecting a given broadcast program for reserve-recording during viewing of the given broadcast program;

maintaining the viewing of the given broadcast program selected at step (b) without interruption while reading program identification information corresponding to the selected given broadcast program from the program identification information pre-stored at step (a); and

setting reserve-recording data using the program identification information read at step (c)."

From Claim 5:

"a key input unit for applying a key input signal for reserve-recording a given broadcast program being viewed by a user;

a controller for maintaining viewing of the given broadcast program when receiving the key input signal from the key input unit, for reading the program identification information corresponding to the given broadcast program from the first storage unit, and for setting reserve-recording information in accordance with the read program identification information; and

a second storage unit for storing the reserve-recording information set by the controller."

From Claim 9:

"a method of reserve-recording a given broadcast program, comprising ...

determining whether a reserve key signal is input by a user for reserve-recording while the user is viewing the given broadcast program;

when the reserve key signal is input by the user during viewing of the given broadcast program, recognizing the given broadcast program being viewed as a broadcast program to be reserve-recorded, and maintaining the viewing of the given broadcast program without interruption; and

reading the program identification information corresponding to the given broadcast program from the first memory, setting reserve-recording information in accordance with the read program identification information, and storing the reserve-recording information in a second memory for reserve-recording."

It is respectfully submitted that the recited features of the inventive method and apparatus,

as set forth above, are not disclosed or suggested in Young *et al.* '266, even when combined with Lawler *et al.* '107 and Yuen *et al.* '203. With respect to the disclosure of Yuen *et al.* '203, and the discussion contained in paragraph 11E of the Answer, the portion of Yuen *et al.* '203 (column 3, lines 10-31) cited by the Examiner merely pertains to an embodiment disclosed in Yuen *et al.* '203, by means of which the user or television viewer can use a picture-in-picture (PIP) format to display a television program listing from a program schedule database in the background, while at the same time viewing a moving, real time image of a program selected from display listings. Thus, as stated in the Appeal Brief, the user is not necessarily viewing broadcast information corresponding to the broadcast being viewed, although that capability is provided.

However, the more important point is that there is no disclosure or suggestion in Yuen *et al.* '203 (or in any of the other references) of the provision of the feature of the present invention whereby the user can select a given broadcast program for reserve-recording during viewing of that program, can maintain viewing of the selected given broadcast program without interruption while reading program identification information corresponding to the selected program, and can then (most importantly) set reserve-recording data using the program identification information read in the previous step so as to achieve reserve-recording of the program. In that regard, with respect to the last step, the portion of Yuen *et al.* '203 cited by the Examiner (column 3, lines 10-31) does not even refer to recording or reserve-recording, but is strictly limited to "full screen television viewing" of a program (quoting from column 3, line 26 of Yuen *et al.* '203).

In section 11E at the top of page 7 of the Answer, the Examiner describes another embodiment of Yuen *et al.* '203, and argues that "Yuen does not provide any suggestion that the channel selected for viewing cannot be the same channel selected for viewing program information" (quoting from page 7, lines 5 and 6 of the Answer). However, the more pertinent fact is that Yuen *et al.* '203 does not provide any suggestion that the channel selected for viewing can be the same channel selected for viewing program information, in combination with the capability of using the program information to set reserve-recording data to be used in reserve-recording the particular program in question.

In section 11F, the Examiner responds to arguments contained on page 10 of the Appeal Brief by admitting that Young *et al.* '266 does not disclose the display of a broadcast while displaying the program guide, and also admitting that Young *et al.* '266 does not disclose that the broadcast being viewed is not a program that has been selected for reserve-recording. However, the Examiner then argues that the combination of the three cited references "does suggest displaying a program that has been selected for reserved [*sic*] recording" (quoting from page 7, lines 15-17 of the Answer). Moreover, in the sentence bridging pages 7 and 8 of the Answer, the Examiner further argues that the combination of the teachings of the three references "would allow the user to select a program for reserved [*sic*] recording while maintaining th viewing of the selected program" (quoting from page 8, lines 1-2 of the Answer). The important point to be considered in connection with these arguments by the Examiner is that the Examiner has not provided any citation to any portion of Young *et al.* '266 which would motivate a person of ordinary skill in the art, upon reviewing the

disclosure of the primary reference, to seek and incorporate the disclosures of Lawler *et al.* '107 and Yuen *et al.* '203 in order to modify the disclosure of Young *et al.* '266, thereby to obtain the present invention. Moreover, as also pointed out in the Appeal Brief, and as further pointed out above, even if those references were properly combined under 35 U.S.C. §103, the result would not be achievement of the present invention, as claimed.

In section 11G, the Examiner takes issue with Appellant's previous argument that the view of a program being watched is subjected to a substantial, and even severe, reduction by 75% or more in size of the broadcast picture. The Examiner argues that the characterization of the reduction as being 75% or more is "unsubstantiated". In that regard, the Examiner's attention is directed to Figure 2 of Yuen *et al.* '203, wherein it is clearly shown that the image of the program being viewed consumes no more than 25% of the display screen, and thus the image of the program being viewed is reduced by at least 75%.

In section 11H, the Examiner again points out that "Yuen does not disclose the amount that the picture is reduced" (quoting from the last two lines on page 8 of the Answer). However, again, the Examiner has referred to Figure 2 of Yuen *et al.* '203, which clearly shows a reduction by at least 75%. In the same section, the Examiner defines the word "viewing" as indicating "watching or looking at something" (quoting from the sentence bridging pages 8 and 9 of the Answer). However, the definition of the term "viewing" is not relevant to the invention being claimed since the language of each of the independent claims includes not simply the word "viewing" but more pertinently the

words "**maintaining** the viewing of the given broadcast program" (emphasis supplied). In that regard, *see* the following: claim 1, line 7, claim 5, line 6; and claim 9, line 11.

In section 11I on page 9 of the Answer, the Examiner responds to further arguments contained in the Appeal Brief by agreeing that Young *et al.* '266 and Lawler *et al.* '107 do not disclose the claimed invention, but then arguing that the combination of those two references with Yuen *et al.* '203 does disclose the claimed invention. In short, the Examiner argues that the combination of the three cited references suggests that the program being viewed is the same as the program selected for reserve-recording (*see* the last two lines on page 9 of the Answer). However, the Examiner again fails to cite any portion of Young *et al.* '266 which would provide motivation to a person of ordinary skill in the art, upon reviewing the primary reference, to seek and incorporate the disclosures of Lawler *et al.* '107 and Yuen *et al.* '203 in order to modify the disclosure of Young *et al.* '266 and achieve the present invention, as claimed. In the absence of such an argument or provision of such information on the part of the Examiner, the rejection under 35 U.S.C. §103 must be considered to be an improper combination of references under that statute.

In section 11J of the Answer, the Examiner responds to further arguments contained in the Appeal Brief by admitting that "Young uses the entire television to display the programming information" (quoting from page 10, lines 6-7 of the Answer". In this regard, it is clear that, by the Examiner's own admission, Young *et al.* '266 teaches away from simultaneous viewing of a given broadcast program selected for reserve-recording and program identification information

corresponding to the selected given broadcast program, as recited in independent claims 1, 5 and 9 of the present application. Thus, this "teaching away from" the present invention in Young *et al.* '266 would certainly not serve as a motivation to a person of skill in the art to seek and incorporate any other references in order to modify Young *et al.* '266 in order to achieve such simultaneous viewing of a program and its program identification information. Thus, by the Examiner's own admission, Young *et al.* '266 contains a disclosure which would not motivate, but in fact would discourage, a person of ordinary skill in the art from seeking any other references for the purpose of modifying the disclosure of Young *et al.* '266 in order to achieve the feature of the claimed invention whereby "the viewing of the broadcast program selected" for reserve-recording is maintained "while reading program identification information corresponding to the selected given broadcast program" (quoting from claim 1, lines 5-9). In the latter regard, *see* the other corresponding portions of claims 5 and 9.

In section 11K of the Answer, the Examiner responds to arguments contained on pages 12 and 13 of the Appeal Brief. Specifically, at the top of page 11 of the Answer, the Examiner cites portions of Lawler *et al.* '107 which allegedly "allows selection of a program for recording from the program guide without the user having to set start and end times, channel, etc" (quoting from page 11 lines 1-3 of the Answer). The Examiner then concludes that allowing the user to select recording of a program "is considered by the examiner to be equivalent to setting reserved [*sic*] recording" (quoting from page 11, lines 3-5 of the Answer). It is respectfully submitted that this is a conclusion drawn by the Examiner based on the Examiner's own opinion, and is unsupported by reference to

any portion of Young *et al.* '266 which would motivate a person of ordinary skill in the art, upon reviewing that reference, to seek and incorporate the disclosures of the two secondary references in order to modify Young *et al.* '266 so as to achieve the present invention. Furthermore, it is submitted that one of ordinary skill in the art, upon reviewing the primary reference, would not be able to draw the same opinion-based conclusion as the Examiner has drawn since the person of ordinary skill in the art, as of the date of the invention, would not have had the benefit of reviewing the disclosure of the present application, as the Examiner has had.

In section 11L of the Answer, the Examiner responds to arguments contained on page 13 of the Appeal Brief, and again cites the combination of Young *et al.* '266 with the two secondary references, arguing that the combination suggests the setting of reserve-recording of a program currently being viewed without interruption. However, again, there is no citation to any portion of Young *et al.* '266 which would provide motivation to a person of ordinary skill in the art, at the time of the invention, to seek and incorporate of the disclosures of the two secondary references for the purpose of modifying the disclosure of Young *et al.* '266 in order to achieve the present invention.

In section 11M of the Answer, the Examiner argues that "Young does not disclose a reason to incorporate the teachings of Lawler because Lawler provides improvements to Young" (quoting from page 12, lines 7 and 8 of the Answer). This statement by the Examiner provides support to Appellant's argument that the combination of references is an improper combination under 35 U.S.C. §103. That is to say, in order for a combination of references to be valid under 35 U.S.C. §103, there

must be some suggestion in the primary reference which would lead a person of ordinary skill in the art, at the time of the invention, to seek the improvements provided by other secondary references. Thus, in the statement quoted above, the Examiner is admitting that Young *et al.* '266 does not contain any disclosure or suggestion which would motivate a person of ordinary skill in the art to seek improvements disclosed in the other, secondary references. Thus, the rejection under 35 U.S.C. §103 must be considered improper, and should be withdrawn on that basis alone.

In the last sentence in section 11M on page 12 of the Answer, the Examiner states that "[c]learly, these features make the setting of reserved [*sic*] recording easier for the user", apparently pointing out a beneficial result achieved from combining the references. However, the identification of a beneficial result achieved from combining references is not a sufficient basis for a combination of the references under 35 U.S.C. §103. As stated above, in order that a rejection under 35 U.S.C. §103 based on a combination of references be valid, there must be some suggestion in the primary reference which would motivate a person of ordinary skill in the art to seek the secondary references for the purposes of modifying the primary reference in order to achieve the invention. Stated in other words, the combination of the two secondary references with the primary reference, Young *et al.* '266, must have been an obvious thing to do; that is, it must have been obvious to a person of ordinary skill in the art, upon reviewing the disclosure of Young *et al.* '266 at the time of the invention, to seek the secondary references and to combine their disclosures with that of Young *et al.* '266.

For the reasons stated above, it is submitted that the rejection under 35 U.S.C. §103 based on the combination of Young *et al.* '266 with Lawler *et al.* '107 and Yuen *et al.* '203 must be considered an improper rejection under 35 U.S.C. §103, and thus the final rejection of claims 1 thru 12 on that basis should be withdrawn.

A Request for Oral Hearing and an Appellants' check in the amount of $280.00 drawn to the order of Commissioner accompany this Reply Brief. Should the Request and/or check become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fee.

Respectfully submitted,

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